



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,395	05/04/2005	Kazauko Fujii	2005_0320A	3251
513 7590 07/28/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
MOORE, MARGARET G				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
07/28/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,395

Applicant(s)

FUJII ET AL.

Examiner

Margaret G. Moore

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16 to 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16 to 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/15/08 has been entered.

2. The disclosure and abstract are objected to because of the following informalities: The formula for the layered siloxane found, for instance, on line 15 of page 2, is structurally confusing and incorrect. The Examiner noted this in previous office actions, with respect to the same formula in the claims. At that time, the Examiner should have required correction of the formula in the specification and abstract as well

Appropriate correction is required.

3. Claims 16 to 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not support the newly added requirement that R be an alkyl group of 8 or more carbon atoms. There clearly is no explicit support. Applicants' argument indicates that they believe there is implicit support for this language in the specification but the Examiner does not agree. It simply does not follow from the teachings on page 5 that the alkyl group must have at least 8 carbon atoms. In addition the specification does not support the newly added siloxane formula. While the Examiner understands the what applicants are trying to express with the newly added formula, the new definition allows for an open and undefined x value that simply is not supported by the specification. The subscript "x" was previously limited to .5-2 and now has a new meaning that is not defined in the specification and an undefined range. This allows for an unlimited number of Si atoms in the siloxane, which is

not supported by the specification. Also there is nothing in the specification that supports this new meaning of x. Previously x had a totally different meaning.

4. Claims 16 to 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The newly amended formula remains rejected as being indefinite. X is now defined as a ratio of Si atoms bonded with four oxygen atoms with respect to the total Si atoms. Such a definition can never allow for an x value of greater than 1. That is, there can never be more Si atoms having four oxygen atoms than there are total Si atoms. With this in mind, applicants' various explanations of the formula are quite confusing since pages 6 and 7 of the latest response and explanation includes various scenarios in which x is 1 or 2. In fact, in Exhibit 3, Figure 5, there are 4 Si atoms having four oxygen atoms attached thereto and 6 total Si atoms. This would result in a x ratio, as now defined, of .66. In applicants' explanation, however, they state that x is 2. Thus it is still unclear what exactly is being claimed.

For claim 21, it is confusing to refer to the siloxane of claim 16 as a filler since it can be a liquid. It is unclear how a liquid can be considered a filler.

5. In view of applicants' response, the Examiner has withdrawn the 112, 2nd para. rejection regarding the term "layered" but she notes the following. If the siloxane is solid at room temperature, then it is clear what weight to give the term "layered". If the siloxane is liquid at room temperature the siloxane need not be "layered". Applicants admit this on page 6 of their response when they state that "the liquid does not form a layered structure at room temperature"... but the liquid is "capable" of forming a layered structure.

The Examiner also notes that, as now claimed, the siloxane in claim 16 does not require any Si atoms bonded with four oxygen atoms. The ratio x can apparently be 0.

Art Unit: 1796

6. The Examiner has not cited any prior art against the claims at this time. She notes that a new ground of rejection may be necessitated by applicants' amendment in response to the rejections supra.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
7/22/08